

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the claims and the following remarks.

Claims Status

Claims 1-14 are pending in this Application. Claims 2-5 have been withdrawn and, thus, Claims 1 and 6-14 are under examination. No amendments have been made at this time.

Prior Art Rejection

Claims 1, 6-8 and 10-14 had been rejected as being unpatentable over a combination of Nozawa and Rimai; while Claim 9 had been rejected as being unpatentable over a combination of Nozawa, Rimai and Yachi.

The Examiner takes the position that Nozawa is teaching the chemical composition of a toner as recited in Claim 1. Specifically, the Examiner points to Example 1 of Nozawa to teach that the resin is made up of 170 wt. parts of styrene and 30 wt. parts of butyl acetate. The Examiner then goes on to reason that Nozawa teaches at Column 12, starting at line 50, that the binder resin can be a copolymer of styrene with other monomers. Some of these other monomers, as recited at line 59 of Column 12, can have acidic groups. Thus, the Examiner reasons that the limitation recited in the claim of the resin comprising 0.1 to 15 wt. % of monomer having an acidic group is met by the teachings of Nozawa.

First, Applicants wish to point out that nowhere in Nozawa does he explicitly teach that the binder resin should comprise 0.1 to 15 wt. % of a monomer having a basic or acidic group. It may be true that the binder resin of Nozawa can be a copolymer of styrene and other monomers, but there is no teaching that the other monomer should be (1) present in an amount of 0.1 to 15 wt. % and that the monomer that is present in an amount of 0.1 to 15 wt. % is (2) a monomer having a basic or acidic group. Thus, in

order for Nozawa to meet these claim limitations, he must inherently teach these limitations.

The Examiner will appreciate the fact that none of the examples of Nozawa specifically teach that the binder resin is made with a monomer having an acidic group. Furthermore, as I am sure that the Examiner will appreciate, the various monomers that are listed at Column 12, starting at line 59 of Nozawa, are not necessarily monomers having acidic groups. Thus, Applicants submit that Nozawa does not inherently meet the limitation that 0.1 to 15 wt. % of the binder resin is made of a monomer having an acidic group.

Applicants have also performed tests to demonstrate the criticality of having a binder resin made up of 0.1 to 15 wt. % of a monomer having an acidic group. These tests are presented by way of a Declaration of Mr. Yamazaki which is attached hereto. Specifically, the Examiner's attention is directed to the Tables that are attached to the Declaration. As can be seen in the Tables, various toners were made up having different binder resin compositions. Nozawa 2, is a toner having a copolymeric resin having 0 wt. % of a monomer having an acidic group and Modified 4 is

a toner made from a resin having 16 wt.% of a monomer having an acidic group. Thus, Nozawa 2 and Modified 4 are toners having binder resins which fall on either side of the claim limitation. For comparison purposes, Modified 1 through Modified 3 are three toners having binder resins where the resin falls within the claimed limitation. Specifically, Modified 1 is at the low end having 0.2 wt.%, while Modified 3 is at the upper end having 14 wt. % of a monomer having an acidic group. Modified 2 falls roughly in the middle with 5 wt. % of monomer having an acidic group.

As can be seen by the Tables attached to the Declaration, both fog and half-tone unevenness are superior when the binder resin falls within the specific chemical composition as recited in the claims.

In fact, for a simple numerical comparison, the Examiner should look at the fog after 100,000 copies. In the present Invention, the average value is 0.005. In comparison, both Nozawa 2 and Modified 4, had a fog value of 0.009. Thus, the material that falls within the claimed range has a value of approximately 1.8 times better than the material that falls outside the claimed range. Clearly, the Examiner can appreciate that a factor of 1.8

is not within experimental error but clearly demonstrates that there is a difference which amounts to a patentable difference between the claimed toner and those toners that fall outside of the claimed range.

Respectfully, based on the fact that Nozawa neither explicitly nor inherently teaches, the claim limitation of the chemical composition of the toners as recited herein; and the fact that Applicants have demonstrated the criticality of the claimed composition, it is submitted that Applicants have demonstrated the patentability of their claimed toner.

One Month Extension of Time

Applicants hereby request a one month extension of time within which to file this Response and submit herewith the necessary government fees therefor.

Should any further fees or extensions of time be necessary in order maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit account #02-2275.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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Attached: Executed Declaration of Mr. Hiroshi Yamazaki
signed on May 14, 2007.